

REMARKS

In response to the Office Action, claims 11-51, 62-102, 115-161 and 174-232 have been cancelled without prejudice and claims 237-272 have been added. The Examiner has taken the position that restriction to one of nineteen groups of claims is required under 35 U.S.C. 121. The Examiner placed the claims remaining after entry of this amendment into the following groups:

Group I: Claims 1-10, drawn to a method of coating a medical device having a catechol moiety with a hydrophilic polymer having a hydrosyl, phosphate, sulfate, carboxylate, amide, guanidine, or amine moiety, classified in class 427, subclass 2.1.

Group V: Claims 52-61, drawn to a method of coating a medical device having hydroxyl, phosphate, sulfate, carboxylate, amide, guanidine, or amine moiety with a hydrophilic polymer having a catechol moiety, classified in class 427, subclass 2.1.

Group IX: Claims 103-114, drawn to a method of coating a biomolecule having a hydroxyl, phosphate, sulfate, carboxylate, amide, guanidine, or amine moiety on a medical device having a hydrophilic polymer with a catechol moiety disposed thereon, classified in class 427, subclass 2.1.

Group XIII: Claims 162-173, drawn to a method of coating a biomolecule with a catechol moiety on a medical device having a hydrophilic polymer with a hydroxyl, phosphate, sulfate, carboxylate, amide, guanidine, or amine moiety disposed thereon, classified in class 427, subclass 2.1.

Group XVIII: Claims 233-234, drawn to a medical device coated with hydrophilic polymer attached via catechol moiety, classified in class 623, subclass 1.

Group XIX: Claims 235-236, drawn to a medical device coated with a hydrophilic polymer and then a biomolecule, classified in class 604, subclass 1.

Applicants provisionally elect Group XIX, claims 235-236, with traverse. Withdrawal of the restriction requirement with respect to the groups identified above is respectfully requested for the reasons set forth below.

Applicants traverse the restriction requirement on the ground that no serious burden on the Examiner exists. If the search and examination of an entire application can be made without serious burden, it must be examined on the merits even though it includes claims directed to distinct or independent inventions. MPEP § 803. Applicants submit that the subject matter of Groups I, V, IX, XIII, XVIII and XIX are sufficiently related that a thorough search for the subject matter of either group would encompass a search for the subject matter of all groups.

The subject matter of Groups I, V, IX and XIII are all classified in class 427, subclass 2.1. Each Group of claims relates to the presence of a catechol moiety on a device surface, hydrophilic polymer, and/or biomolecule. Each of the Groups I, V, IX, XIII, also relates to the use of one or more of the following moieties in the method of making the device: hydroxyl, phosphate, sulfate, carboxylate, amide, guanidine, and amine. Searching for the terms for one group of claims should encompass a search for the subject matter of all groups. Groups XVIII and XIX are directed to products made by methods such as the methods of Groups I, V, IX, XIII.

The Examiner acknowledged that the inventions of Groups I, V, IX, XIII are related to the inventions of Groups XVIII and XIX as processes of making and products made. As with the methods claimed in Groups I, V, IX, XIII, the inventions of Groups XVIII and XIX related to coated medical devices having a catechol moiety on the surface of the device, bound to the surface of a device via a catechol moiety on a hydrophilic polymer or a hydrophilic polymer including a catechol moiety chemically bonded to a biomolecule. A thorough search of devices having hydrophilic polymer coatings with or without a biomolecule further including a catechol moiety should encompass a search for the subject matter of all the remaining groups. To avoid duplicative examination by the Patent Office and unnecessary expense to Applicants, Applicants respectfully request examination on the merits of all the remaining claims, not just those of the provisionally elected group.

Support for the new claims added by this amendment is found in the application as originally filed. No new matter is presented.

If any fee is required in connection with these papers, please charge such fee to Deposit Account No. 13-2546.

Respectfully submitted,



Date: October 6, 2004

David P. Ruschke, Reg. No. 40,151
Attorney for Applicant(s)
Medtronic, Inc.
Patent Department
710 Medtronic Parkway NE, M.S. LC340
Minneapolis, MN 55432-3576
Phone: 763-505-2913
Facsimile: 763-505-2530